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REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the following remarks. Claims 1-19 are pending. Claims 1-19 have been rejected.

Claims 1-2, 4-7, 9-15, and 17-19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Cambray et al. (U.S. Patent No. 5,278,898, hereinafter referred to as "Cambray") in view of Friedes et al. (U.S. Patent No. 5,311,572, hereinafter referred to as "Friedes") and Brady (U.S. Patent No. 6,173,052, hereinafter referred to as "Brady"). Applicant respectfully traverses this rejection.

Applicant respectfully submits that the Examiner has failed to provide any suggestion or motivation to combine any of the references as required by MPEP 2142 in order to establish a *prima facie* case of obviousness. Instead, Applicant respectfully submits that the Examiner has improperly used Applicant's own disclosure in order to provide the suggestion or motivation to make the claimed combination as well as the reasonable expectation of success. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ("The teaching or suggestion to make the claimed

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combination and the reasonable expectation of success must be found in the prior art, and not an applicant's disclosure.")

One of the fundamental requirements that the Examiner must overcome when combining two or more references is to provide some motivation why one skilled in the art would pick and choose elements from two or more isolated references in order to come up with Applicant's claimed invention, absent any suggestion from the Applicant's own teaching. The fact that the claimed combination is, for example, merely a combination of features that are individually known in the art does not necessarily result in that invention falling within the ambit of 35 U.S.C. § 103. See *In re Spinnoble*, 56 CCPA 823, 405 F.2d 578, 160 USPQ 237 (1969) ("A patentable invention, within the ambit of 35 USC 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.") Consequently, it is not enough that an examiner finds two or more references that individually do not disclose all of the elements, but which when certain elements from the references are combined read on the claims without providing a suggestion or motivation why one skilled in the art would combine the references.

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In response to Applicant's previous argument that the Examiner has failed to properly establish a motivation to combine Karanicolas and Helms, the Examiner argues,

It should be noted that all three references are classified in 379 and two are classified in the same sub-class. ... In this case, the Brady reference, classified in the same class and subclass as the primary reference (Cambray et al.) was introduced to show that displaying a list of call records and identify information in a call queue, and thereby allowing an agent to manually select a call from the call list is old in the art.

Applicant respectfully submits that the Examiner's above statement does not provide any explanation as to why one skilled in the art would have been motivated to pick and choose elements from the two isolated references in order to come up with Applicant's claimed invention.

The fact that the references are in the same class/subclass is irrelevant for purposes of providing a motivation or suggestion to combine the references. While Applicant traverses the Examiner's above assertions, even if the Examiner's above assertions are true, the Examiner has still failed to provide any motivation as to why one skilled in the art would combine the cited references. At best, the fact that the references are in the same class/subclass is indicative that the references may be

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analogous to each other, though even this is far from determinative since MPEP section 2141.01(a) states "Patent Office classification of references and the cross-references in the official search notes are some evidence of 'nonanalogy' or 'analogy' respectively'". (*Emphasis added.*) Rather, the Examiner simply recites elements from the two references and then makes the bald, unsupported assertion that the combination of these elements "would have been obvious to a person having skill in the art."

The Examiner's statement that the combination of the elements "would have been obvious to a person having skill in the art" merely suggests that it would have been "obvious to try" the claimed combination of elements. Applicant submits that this is not a proper test for patentability. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) ("Obvious to try" is not a proper standard for determining teaching, suggestion or motivation supporting the combination.) While Applicant traverses the Examiner's conclusion that the cited references can be combined, the mere fact that the reference could be combined is insufficient to establish a *prima facie* case of obviousness. See *In re Mills*, 916 F.2d 6680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device "may be cable of being modified to

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run the way the apparatus is claimed, there must be a suggestion or motivation in the reference is to do so.") See also MPEP section 2143.01 (Fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness.)

Applicant submits that the rationale against the "obvious to try" theory and "references could be combined" theory is that these theories are inherently based on hindsight reasoning, and thus do not provide any motivation or suggest to combine the alleged references. The courts have routinely held that hindsight reasoning is improper. See, for example, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Circ. 1988) (cited by the Examiner in the RESPONSE TO APPLICANT ARGUMENTS section of the present office action apparently for the proposition that the motivation to combine may be found in the knowledge generally available to one of ordinary skill in the art):

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." [*W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)] It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only

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with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.

Often, an assertion that an examiner's conclusion of obviousness is based on improper hindsight reasoning results in *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) being cited for the proposition that,

[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a rejection is proper.

Applicant respectfully asserts that this passage does not relinquish an examiner's requirement to provide a motivation or suggestion for the alleged combination of references. Rather, an examiner is still required to provide a motivation or suggestion for the alleged combination of references. In the present case, Applicant submits that the Examiner has provided no such suggestion or motivation beyond Applicant's own disclosure or the bald assertion that it "would have been obvious to a person having skill in the art."

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What the Examiner has done, in effect, is combine certain elements from Cambray, Friedes, and Brady in a vacuum without taking into consideration what problems these references solve and whether those problems are related to the problems associated with or related in any way to the present invention. For example, Cambray relates to a solution for electronically managing calls in a hold queue. In contrast, Friedes relates to a solution for routing calls using information stored in two or more databases. (See, for example, Abstract of Cambray.) On column 13, line 22-column 15, line 59, Friedes provides a detailed example illustrating how the system routes calls to different agents based on user-defined criteria within an insurance company.

Let us assume that an insurance company has a total of ten locations ... Let us further assume that the company wants all calls from holders of an insurance policy with a face value of \$1 million or more to be routed to either the supervisors or the assisted supervisors at certain locations ... Similarly, the company wishes to route calls from holders of policy with a face value between half a million dollars and a million dollars to no more than two stations at certain locations staffed by product specialists with exceptional interpersonal skills and expert knowledge in either life or property insurance. Calls from other policyholders can be routed to any attendant in any locations so long as records of their policies are stored in a local database.

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Applicant submits that Friedes does not relate at all to holding queues. In contrast, in the event the system disclosed in Friedes is unable to route a call within a predetermined time interval, the system uses a default routing logic and/or to complete the call. (See column 17, lines 19-23.) In fact, the only references to "queues" in Friedes is on column 16, line 7 (wherein Friedes discloses that the number of calls in a queue at a given time for a specific location can be used to determine where to route an incoming call) and on column 17, line 51 (wherein Friedes discloses that a call can be sent to a queue during peak traffic periods). Accordingly, Applicant respectfully submits that there is no suggestion or motivation for one skilled in the art to combine specific elements from the routing system disclosed in Friedes with the system for electronically managing calls in a hold queue as disclosed in Cambray without impermissibly relying on Applicant's own disclosure to disclose the desirability of the combination of the elements.

As discussed above, merely because the references are related, *could* be combined, or individually disclose certain elements or pieces of the present invention is not sufficient to establish that the present invention is obvious in view the



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references without providing some suggestion or motivation for the alleged combination.

For at least the reasons discussed above, Applicant submits that the Examiner has failed to provide any motivation or suggestion to combine the alleged references. Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Accordingly, Applicant respectfully requests that the finality of the present Office Action be withdrawn, and that the pending claims be allowed to issue.

The Examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

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